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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,181	05/29/2001	Dana Howard Jones	513612000100	6792

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EXAMINER	
POND, ROBERT M	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/867,181	JONES, DANA HOWARD	
	Examiner	Art Unit	
	Robert M. Pond	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-5,9-16,18,21-24,26-31,34 and 36-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,9-16,18,21-24,26-31,34 and 36-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/29/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 September 2005 has been entered.

Response to Amendment

The Applicant amended claims 1, 4, 5, 9, 16, 21, 24, 26, 27-31, 34, and 36-39, and canceled claims 2, 6-8, 17, 19, 20, 25, 32, and 35, and newly added claim 40. All pending claims (1, 3-5, 9-16, 18, 21-24, 26-31, 34, and 36-40) were examined in this non-final office action. Please note, claim 33 is omitted from the Applicant's claims and is assumed to be canceled. Correction to claims is required in any subsequent reply to this office action to clearly indicate the status of claim 33.

Response to Arguments

Applicant's arguments, see Remarks, filed 19 September 2005, with respect to the rejection(s) of claim(s) 1-3, 6, 7, 10-32, 34, 37, and 38 under 35 USC 102

have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Goldhaber and Official Notice.

Goldhaber discloses consumers desiring intellectual property (e.g. movies, magazine, pre-recorded music) from a source and making payment (see at least Fig. 2; col. 10, lines 9-38), or a consumer receiving compensation for viewing a sponsor's message pertaining to product (e.g. lingerie) (see at least Fig. 3; col. 10, lines 39-57). Goldhaber further discloses intellectual property as being positively priced or free (see at least col. 6, lines 3-8). One of ordinary skill in the art would ascertain free intellectual property as being a target item for attention brokerage. One of ordinary skill in the art would further ascertain a quid pro quo arrangement whereby a sponsor either gives the intellectual product away to the consumer in return for viewing the sponsor's message or provide alternate compensation for viewing a sponsor's message.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. **Claims 1, 3, 10-16, 18, 21-24, 26-31, 34, 37, and 38 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (Paper #2, US 5,794,210) in view of Official Notice (regarding within the skill, hereinafter referred to as ON1).**

Goldhaber teaches a method of advertisers gaining the attention of consumers accessing the Internet via attention brokerage and compensating consumers who pay attention to the advertisement (please see at least title, abstract; col. 4, lines 34-35; col. 9, lines 34-36). Goldhaber teaches advertisers as sponsors embedding advertisements with content most likely to reach the advertiser's target audience referred to as linking sponsorship (see at least col. 2, lines 24-27). Goldhaber teaches decoupling advertising from the content referred to as orthogonal sponsorship (see at least col. 5, lines 46-47). Goldhaber further teaches:

- *Providing a product at a networking site; product covered by intellectual property:* (see at least abstract; Fig. 1 (102); col. 1, lines 4-8; col. 3, lines 51-55; col. 5, lines 11-13; col. 6, lines 3-7; col. 9, lines 32-41).

- *Media content covered by intellectual property::* consumers desiring intellectual property (e.g. movies, magazine, pre-recorded music) from a source and making payment for IP (see at least Fig. 2; col. 10, lines 9-38); or a consumer receiving compensation for viewing a sponsor's message pertaining to product (e.g. lingerie) (see at least Fig. 3; col. 10, lines 39-57). Goldhaber further discloses intellectual property as being positively priced or free (see at least col. 6, lines 3-8).
- *Restricting access to product:* restricts access to valuable information until information provider receives compensation (e.g. television program, prerecorded music, magazine or newspaper article, research report)
- *Facilitating the display of a sponsor message to a consumer:* (see at least abstract; col. 9, lines 62-67).
- *Allowing access to a product after facilitating display; purchasing product:* seeing an ad and requesting the film clip; making a purchase (see at least Fig. 13 (314); col. 5, lines 11-13; col. 18, lines 53-55).
- *Maintaining a consumer activity log:* creates consumer profile; maintains profile, updates profile (see at least col. 13, line 33 through col. 14, lines 56).
- *Authoring sponsor message:* advertiser creates ad at site (see at least Fig. 8 (68, 106); col. 14, lines 17-20).

- *Consumer sign-up:* providing personal data, contact data, profile data, taking acceptance action, password (see at least col. 12, line 45 through col. 13, line 40).

Goldhaber teaches all the above as noted under the 103(a) rejection and further teaches a) consumers desiring intellectual property (e.g. movies, magazine, pre-recorded music) from an online source and making payment for a positively priced item (see at least Fig. 2; col. 10, lines 9-38) or receiving the product for free (see at least col. 6, lines 3-8), and further teaches a consumer receiving compensation for viewing a sponsor's message pertaining to product (e.g. lingerie) (see at least Fig. 3; col. 10, lines 39-57). The Examiner takes the position that it would have been obvious to one of ordinary skill in the art at time of the invention to disclose intellectual property that is given away for free as being a target item for attention brokerage. The Examiner takes the position that that it would have been obvious to one of ordinary skill in the art at time of the invention to disclose making a business decision to provide a free item to a consumer in return for viewing a sponsor's message. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Goldhaber to give a consumer intellectual property away for viewing a sponsor's message as taught by ON1, in order to provide the consumer with intellectual property, and thereby encourage the consumer to return to the service.

2. **Claims 4, 5, 36, and 40 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (Paper #2, US 5,794,210) and ON1 (regarding within the skill), as applied to claims 1 and 24, further in view Wiser (Paper #2, US 6,385,596).**

Goldhaber and ON1 teach all the above as noted under the 103(a) rejection and teach a) advertising intellectual property products, b) compensating information providers for purchased content (e.g. prerecorded music, television programs, search reports), and c) trading houses providing automatic royalty tracking (see at least col. 19, line 19 through col. 20, line 53; col. 20, lines 54-55), but do not disclose making royalty payments. Wiser teaches protecting a content owner's intellectually property rights over a network, and further teaches tracking and making royalty payments to a content owners and facilitators (see at least col. 9, lines 39-53; col. 11, lines 49-61). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber and ON1 to disclose making royalty payments as taught by Wiser, in order to disclose the purpose of royalty tracking, and thereby attract content owners and facilitators to the service desiring to be paid royalties.

Goldhaber and ON1 teach all the above as noted under the 103(a) rejection, but do not disclose entering into a license agreement with the owner of the intellectual property. Wiser teaches all the above as noted under the 103(a) rejection and further teaches consumers and facilitators entering into a license agreement with the owner of intellectual property (see at least abstract; Fig. 1A

(108, 116); Fig. 1B (110); col. 1, lines 45-47; col. 5, lines 56; col. 10, lines 18-48). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber and ON1 to implement licensing as taught by Wiser, in order to protect the intellectual property rights of the product owner.

3. **Claims 9 and 39 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber (Paper #2, US 5,794,210) and ON1 (regarding within the skill), further in view of Official Notice (regarding within the skill, hereinafter referred to as ON2).**

Goldhaber and ON1 teach all the above as noted under the 103(a) rejection and further teach inactivating a CyberCoin to prevent a consumer from receiving additional compensation by merely accessing the same advertisement (see at least col. 17, lines 49-52), but does not disclose barring the owner of intellectual property from pretending to be a consumer. The Examiner takes the position that it would have been obvious to one of ordinary skill in the art at time of the invention to disclose barring the content provider from pretending to be a consumer, since it is within the skill to ascertain that content providers are capable of abusing the system as well as consumers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Goldhaber and Official Notice to disclose barring the owner of intellectual property from pretending to be a consumer as taught by ON2, in order

to protect the system from abusive users, and thereby attract consumers and providers to the service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-6760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Pond
Primary Examiner
November 21, 2005